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10
11 UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

12 BONNIE STERN GOLD,) Case No.: C07-02450 EMC
13 Plaintiff,)
14 vs.) **ANSWER OF DEFENDANT**
15 ANTHONY ROBERTS, and DOES 1-10,,) **ANTHONY ROBERTS TO COMPLAINT**
16 Defendants.)
17)
18)
19)
-----)

20 Defendant Anthony Roberts (“Roberts”) answers the Complaint (“Complaint”) of
21 plaintiff Bonnie Sterngold as follows:

22 **THE PARTIES**

23 1. Plaintiff Bonnie Sterngold is an individual having a mailing address at 15 Peak
24 Lane, Portola Valley, California 94028.

25 **Answer:**

26 In response to paragraph 1 of the Complaint, defendant is without sufficient information
27 to admit or deny the allegations in paragraph 1, and therefore denies the same.

28 2. Upon information and belief, defendant Anthony Roberts is an individual having

a mailing address at 820 S. Washington Street, Diamond, Missouri 64840.

Answer:

In response to paragraph 2 of the Complaint, Roberts admits the allegations contained in paragraph 2 of the Complaint.

NATURE OF ACTION

6 3. This is an action for trademark infringement and false designation of origin under
7 the Trademark Act of 1946, as amended (The Lanham Act, 15 U.S.C. § 1051 et seq.), trademark
8 dilution under Section 14430 of the Business and Professions Code of the State of California,
9 and unfair competition under the common law and Section 17200 of the Business and
10 Professions Code of the State of California, based on the Defendant's adoption and use of
11 "Stirling" as a brand name for sharpeners in violation of Plaintiff's established rights in
12 "Sterling" as a registered trademark for sharpeners.

Answer:

14 In response to paragraph 3 of the Complaint, defendant admits that plaintiff filed a
15 lawsuit pleading causes of action for trademark infringement under U.S.C. section 1051 *et seq.*,
16 false designation of origin, common law unfair competition and trademark infringement and
17 trademark dilution under California law. Except as so admitted, defendant denies each and every
18 allegation in paragraph 3 of the Complaint.

JURISDICTION AND VENUE

20 4. This Court has jurisdiction over this action pursuant to 15 U.S.C. §1121 (actions
21 arising under the Federal Trademark Act), 28 U.S.C. 1338(a) (acts of Congress relating to
22 trademarks), 28 U.S.C. § 1338(b) (pendent unfair competition claims). Venue is proper in this
23 District pursuant to 28 U.S.C. 1391(b).

Answer:

25 In response to paragraph 4 of the Complaint, defendant admits that this Court has subject
26 matter jurisdiction over this action. Defendant denies that this Court has personal jurisdiction
27 over the defendant, and further denies that this venue is proper.

COUNT ONE

(Infringement of Federal Trademark Registration No. 2311151)

5. Plaintiff hereby realleges and incorporates by reference the allegations of paragraph 1 through 5 of this Complaint as if fully set forth herein.

Answer:

In response to paragraph 5 of the Complaint, defendant repeats and incorporates herein his answers to paragraphs 1 through 4, inclusive, as if fully set forth herein.

6. Plaintiff is the owner of United States Trademark Registration No. 2311151, registered January 25, 2000, for "Sterling" (for hand tools, namely knife sharpeners in Class 008) a certified copy of which is attached hereto as Exhibit A. This registration is now valid, subsisting, uncancelled and unrevoked.

Answer:

In response to paragraph 6 of the Complaint, defendant is without sufficient information to admit or deny the allegations in paragraph 6, and therefore denies the same.

7. Continuously since on or about August 12, 1992, plaintiff has used its "Sterling" mark in connection with and to identify its sharpeners and to distinguish said products from similar products offered by other companies, by, and without limitation, prominently displaying said mark on sharpeners and advertising and promotional materials distributed throughout the United States. Plaintiff's products sold under the "Sterling" mark and brand name are provided nationwide including in the State of California.

Answer:

In response to paragraph 7 of the Complaint, defendant is without sufficient information to admit or deny the allegations in paragraph 7, and therefore denies the same.

8. In addition, as of the date of the filing of this complaint, plaintiff is actively engaged in expanding its use of the "Sterling" in connection with sharpeners in interstate commerce throughout the United States including in the State of California.

Answer:

In response to paragraph 8 of the Complaint, defendant is without sufficient information

1 to admit or deny the allegations in paragraph 8, and therefore denies the same.

2 9. Defendants have infringed plaintiff's mark in interstate commerce by various acts,
 3 including, without limitation, the selling, offering for sale, promotion and advertising sharpeners
 4 under the name "Stirling" of a type virtually identical to the type of sharpeners offered by
 5 plaintiff, prominently displaying, advertising, and promoting sharpeners under the name
 6 "Stirling."

7 **Answer:**

8 In response to paragraph 9 of the Complaint, defendant admits selling sharpeners of a
 9 different design than plaintiff's sharpener, with defendant's sharpeners bearing the name
 10 "Stirling" from approximately 1997 to 2002. Defendant admits selling sharpeners of a different
 11 design than plaintiff's sharpener, with defendant's sharpeners bearing the name "Tony's
 12 Sharpeners" from 2002 to present with an instruction sheet that references the name "Stirling" in
 13 a non-trademark sense. The only marketing defendant has conducted for his sharpener since
 14 2002 is by attending trade shows. Except as so admitted, defendant denies each and every
 15 allegation in paragraph 9 of the Complaint.

16 10. Defendant's use of "Stirling" in connection with sharpeners is without permission
 17 or authority of the plaintiff and said use is likely to cause confusion, to cause mistake and/or to
 18 deceive.

19 **Answer:**

20 In response to paragraph 10 of the Complaint, defendant denies each and every allegation
 21 in paragraph 10 of the Complaint.

22 11. Defendant's use of "Stirling" in connection with sharpening products has been
 23 made notwithstanding plaintiff's well-known and prior established rights in the trademark
 24 "Sterling" and with both actual and constructive notice of plaintiff's federal registration rights
 25 under 15 U.S.C. § 1072.

26 **Answer:**

27 In response to paragraph 11 of the Complaint, defendant denies each and every allegation
 28 in paragraph 11 of the Complaint.

1 12. Upon information and belief, defendant's infringing activities have cause and,
 2 unless enjoyed by this Court, will continue to cause, irreparable injury and other damage to
 3 plaintiff's business, reputation and good will in its federally registered "Sterling" trademark.
 4 Plaintiff has no adequate remedy at law.

5 **Answer:**

6 In response to paragraph 12 of the Complaint, defendant denies each and every allegation
 7 in paragraph 33 of the Complaint.

8 **COUNT TWO**

9 **(False Designation of Origin Under 15 U.S.C. § 1125(A))**

10 13. Plaintiff hereby realleges and incorporates by reference the allegations of
 11 paragraphs 1-12 of this Complaint as if fully set forth herein.

12 **Answer:**

13 In response to paragraph 13 of the Complaint, defendant repeats and incorporates herein
 14 his answers to paragraphs 1 through 12, inclusive, as if fully set forth herein.

15 14. Upon information and belief, defendant has used the designation "Stirling" in
 16 connection with sharpening products in interstate commerce. Said use of the designation
 17 "Stirling" is a false designation of origin, a false or misleading description and representation of
 18 fact which is likely to cause confusion and to cause mistake, and to deceive as to the affiliation,
 19 connection or association of defendant with plaintiff and as to the origin, sponsorship, or
 20 approval of defendant's products and commercial activities by plaintiff.

21 **Answer:**

22 In response to paragraph 14 of the Complaint, defendant denies each and every allegation
 23 in paragraph 14 of the Complaint.

24 15. Upon information and belief, defendant's wrongful activities have caused, and
 25 unless enjoyed by this Court will continue to cause, irreparable injury and other damage to
 26 plaintiff's business, reputation and good will in its "Sterling" mark. Plaintiff has no adequate
 27 remedy at law.

28

1 **Answer:**

2 In response to paragraph 15 of the Complaint, defendant denies each and every allegation
 3 in paragraph 15 of the Complaint.

4 **COUNT THREE**5 **(Common Law Unfair Competition and Trademark Infringement)**

6 16. Plaintiff realleges and incorporates by reference the allegations of paragraphs 1
 7 through 15 of this Complaint as if fully set forth herein.

8 **Answer:**

9 In response to paragraph 16 of the Complaint, defendant repeats and incorporates herein
 10 his answers to paragraphs 1 through 15, inclusive, as if fully set forth herein.

11 17. Defendant's activities as stated herein constitute unfair competition and an
 12 infringement of plaintiff's common law trademark rights in the name "Sterling" within the State
 13 of California and in violation of California law.

14 **Answer:**

15 In response to paragraph 17 of the Complaint, defendant denies each and every allegation
 16 in paragraph 17 of the Complaint.

17 18. Upon information and belief, defendant's wrongful and infringing activities have
 18 caused, and unless enjoined by this Court will continue to cause, irreparable injury and other
 19 damage to plaintiff's business, reputation and good will in its "Sterling" mark. Plaintiff has no
 20 adequate remedy at law.

21 **Answer:**

22 In response to paragraph 18 of the Complaint, defendant denies each and every allegation
 23 in paragraph 18 of the Complaint.

24 **COUNT FOUR**25 **(Trademark Dilution Under California Law)**

26 19. Plaintiff realleges and incorporates by reference the allegations of paragraphs 1-
 27 18 of this Complaint as if fully stated herein.

28

1 | Answer:

In response to paragraph 1 of the Complaint, defendant repeats and incorporates herein his answers to paragraphs 1-18, inclusive, as if fully set forth herein.

4 20. Plaintiff's "Sterling" trademark constitutes a famous mark in the State of
5 California pursuant to Section 14430 of the Business and Professions Code of the State of
6 California which mark because famous prior to the commencement of defendant's activities as
7 alleged herein.

8

Answer:

9 In response to paragraph 20 of the Complaint, defendant denies each and every allegation
10 in paragraph 20 of the Complaint.

11 21. Upon information and belief, defendant's activities as alleged herein dilute the
12 distinctive quality of plaintiff's "Sterling" mark in violation of Section 14430 of the Business
13 and Professions Code of the State of California.

14 | **Answer:**

15 In response to paragraph 21 of the Complaint, defendant denies and every allegation in
16 paragraph 21 of the Complaint.

17 22. Upon information and belief, defendant's wrongful activities have caused, and
18 unless enjoined by this Court will continue to cause, irreparable injury and other damage to
19 plaintiff's business, reputation and good will in its "Sterling" mark. Plaintiff has no adequate
20 remedy at law.

21 | **Answer:**

22 In response to paragraph 22 of the Complaint, defendant denies each and every allegation
23 in paragraph 22 of the Complaint.

COUNT FIVE

(Violations of the California Unfair Practices Act)

26 23. Plaintiff realleges and incorporates by reference the allegations of paragraphs 1
27 through 22 of this Complaint as if fully set forth herein.

1 **Answer:**

2 In response to paragraph 23 of the Complaint, defendant repeats and incorporates herein
3 his answers to paragraphs 1-22, inclusive, as if fully set forth herein.

4 24. Defendant's activities alleged herein constitute unfair deceptive acts and practices
5 in the conduct of its trade and business in violation of Section 17200 of the Business and
6 Professions Code of the State of California.

7 **Answer:**

8 In response to paragraph 24 of the Complaint, defendant denies each and every allegation
9 in paragraph 24 of the Complaint.

10 25. Upon information and belief, defendant's wrongful and deceptive activities have
11 caused, and unless enjoined by this court will continue to cause, irreparable injury and other
12 damage to plaintiff's business, reputation and good will in its "Sterling" mark. Plaintiff has no
13 adequate remedy at law.

14 **Answer:**

15 In response to paragraph 25 of the Complaint, defendant denies each and every allegation
16 in paragraph 25 of the Complaint.

17 **AFFIRMATIVE DEFENSES**

18 **First Affirmative Defense**

19 **(Failure to State a Claim)**

20 26. Defendant is informed and believes and on that basis alleges that the Complaint
21 and each purported claim in the Complaint, fails to state facts sufficient to constitute a claim
22 against defendant. The Complaint, in whole or in part, should be dismissed pursuant to Federal
23 Rules of Civil Procedure 12(b)(6).

24 **Second Affirmative Defense**

25 **(Statute of Limitations)**

26 27. Defendant is informed and believes and on that basis alleges that the Complaint,
27 and each purported claim in the Complaint, is barred by the applicable statute of limitations.

28

Third Affirmative Defense **(Laches)**

28. Defendant is informed and believes and on that basis alleges that the Complaint and each purported claim in the Complaint, is barred by the doctrine of laches.

Fourth Affirmative Defense

(Acquiescence)

29. Defendant is informed and believes and on that basis alleges that the Complaint and each purported claim in the Complaint, is barred by the doctrine of acquiescence.

Fifth Affirmative Defense

(Estoppey)

30. Defendant is informed and believes and on that basis alleges that the Complaint, and each purported claim in the Complaint, is barred by the doctrine of estoppel.

Sixth Affirmative Defense **(Waiver)**

31. Defendant is informed and believes and on that basis alleges that the Complaint, and each purported claim in the Complaint, is barred by the doctrine of waiver.

Seventh Affirmative Defense

(Fair Use)

32. Defendant is informed and believes and on that basis alleges that the Complaint, and each purported claim in the Complaint, is barred because defendant's use of "Stirling" is a fair use.

Eighth Affirmative Defense

(First Amendment)

33. Defendant is informed and believes and on that basis alleges that the Complaint, and each purported claim in the Complaint, is barred because defendant's use of "Stirling" is protected by the First Amendment of the United States Constitution.

Ninth Affirmative Defense

(Failure to Mitigate)

34. Defendant is informed and believes and on that basis alleges that to the extent plaintiff failed to mitigate the damages it allegedly sustained, any recovery against defendant must be reduced accordingly.

Tenth Affirmative Defense

(Personal Jurisdiction)

35. Defendant is informed and believes and on that basis alleges that the Complaint, and each purported claim in the Complaint, is barred because this Court lacks personal jurisdiction over defendant.

36. Defendant reserves the right to assert additional defenses or affirmative defenses that may arise as discovery progresses or that he otherwise becomes aware of during the course of this litigation.

PRAYER FOR RELIEF

WHEREFORE, defendant Anthony Roberts prays for judgment against plaintiff Bonnie Sterngold as follows:

1. That plaintiff takes nothing by her Complaint;
 2. For such other and further relief as the Court deems just and proper.

Dated: November 1, 2007

GREENAN, PEFFER, SALLANDER & LALLY LLP

By: /S/
James S. Greenan
Attorneys for Defendant
ANTHONY ROBERTS